

## II. REJECTIONS UNDER 35 U.S.C. §103

### A. U.S. Patent No. 4,842,849 to Grollier et al.

In the current Office Action, the Examiner newly rejects claims 1-6, 9-20, 26, 29-39, and 43-91 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,842,849 to *Grollier et al.* Applicants respectfully traverse this rejection.

According to the Examiner, *Grollier* teaches oxidation dyeing compositions comprising cyclic polymers and poly-quaternary ammonium polymers as presently claimed. Office Action, p. 2. The Examiner also contends that *Grollier* teaches a dyeing method “similar” to those claimed and suggests the kit as claimed. *Id.*, p. 4. The Examiner admits, however, that *Grollier* does not teach or disclose the presently claimed combination of at least one cyclohomopolymer and at least one polyquaternary ammonium polymer. *Id.*, p. 5. Nevertheless, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art to formulate hair dyeing compositions as taught by *Grollier* because, among other things, “a dye composition that comprises oxidation bases and cationic polymers is expressly suggested by [*Grollier*] and therefore, is an obvious formulation.” *Id.*

Applicants disagree. M.P.E.P. § 2143 requires that, to establish a *prima facie* case of obviousness, an Examiner must show, among other things, that there exists some suggestion or motivation to modify the teachings of a cited reference to obtain the presently claimed invention and that there would have been a reasonable expectation of success in doing so. Here, the Examiner has failed to meet either of these criteria.

First, the Examiner has failed to point to any guidance in *Grollier* that would lead one of ordinary skill in the art to choose **both** a cyclohomopolymer of dialkyldiallylammonium **and** a quaternary ammonium polymer and use them together in

an oxidation dyeing composition. Although both of these cationic polymers are disclosed in *Grollier*, they are disclosed in a list of 13 preferred types of cationic polymers, spanning from columns 2-8 of the patent. There is no recognition in *Grollier* of the advantages of using both of these polymers together, let alone together in an oxidation dyeing composition. Example 19, pointed to numerous times by the Examiner, shows an oxidation dyeing composition comprising a quaternary ammonium polymer. But nothing in the entire disclosure of *Grollier*, which includes 30 examples, suggests using these two specific polymers, as opposed to any other combination of polymers, and/or using them with an oxidation dye.

Further evidence to support Applicant's position can be found in the fact that the presently claimed combination of ingredients remedies the roughness, fragility, and ease of tangling seen in keratin fibers prior to the Applicants' invention. See Substitute Specification, ¶ 5. *Grollier*, in contrast, teaches that it is the use of anionic polymers **with vinylsulphonic units** that results in, inter alia, easier comb-out, a pleasant feel of hair when wet, and shine, hold, and volume of the hair when dry. *Grollier*, col. 1 ll. 14-20; see also col. 1 ll. 28-37. In fact, each of the examples in the *Grollier* patent, with the exception of examples 20-23 (which describe reducing compositions only), describe a composition that contains anionic polymers with vinylsulphonic units. There is thus no recognition in the reference that the presently claimed combination would have advantageous properties without the vinylsulphonic polymer. As the Federal Circuit has stated, it is not permissible to pick and choose only so much of any given reference as will support a given position and ignore the reference in its totality. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986) (citations omitted).

Second, the Examiner has stated that one of ordinary skill in the art would have had a reasonable expectation of success in using the cationic polymers described in *Grollier* in a dyeing composition and to optimize the amounts and ratios in order to get the “maximum effective amounts.” Office Action, p. 5. Applicants disagree, as they believe that *Grollier* actually teaches away from the invention described in the present application. While *Grollier* discloses a long list of cationic polymers that may be used, and also discloses that “at least one” can be used, it does not disclose—nor suggest—use of the two presently claimed specific polymers in combination. As noted above, *Grollier* teaches that it is the use of anionic polymers containing vinylsulphonic units that produces beneficial results on keratin fibers. *Grollier* simply doesn’t suggest or motivate one of skill in the art to prepare the compositions of the present invention to provide the benefits of the present invention.

In conclusion, the Examiner has not met the initial burden of establishing a prima facie case of obviousness as required by M.P.E.P. § 2143 because he has not shown:

- (1) motivation to remove the required anionic polymeric ingredient of *Grollier*;
- (2) motivation to use two of *Grollier*’s cationic polymers, listed as alternatives, **together**;
- (3) motivation to use the combination of specific polymers, without the required vinylsulphonic ingredient, in an oxidation dyeing composition; or
- (4) a reasonable expectation of success in doing any of the above.

Accordingly, Applicants respectfully request that the Examiner withdraw this rejection of the pending claims over *Grollier*.

**B. U.S. Patent No. 4,842,849 to Grollier et al. in view of U.S. Patent No. 5,976,195 to de la Mettrie et al.**

The Examiner also rejects claims 7-8, 21-25, 27-28, and 40-42 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,976,195 to *de la Mettrie et al.* in view of *Grollier*. Applicants respectfully traverse this rejection as the Examiner has not provided sufficient or proper justification for combining bits and pieces of these two references to reject the pending claims.

In the Office Action, the Examiner alleges that *Grollier* “teaches a hair dye composition comprising cationic polymers, oxidation bases, and oxidation agents of hydrogen peroxide” but admits that *Grollier* does not teach cationic polymers with the specific parameters of claims 7 and 8, oxidation bases as claimed in claims 21-25 and 27-28, or enzymes as oxidizing agents as set forth in claim 40. Office Action, p. 5. To remedy these deficiencies, the Examiner relies on *de la Mettrie*, which, according to the Examiner, “teaches in another analogous art of hair dyeing” oxidation bases and enzymes as oxidation agents. Office Action, p. 6. The Examiner then mines the disclosure of *de la Mettrie* for the limitations present in claims 7-8 and the oxidation bases and agents claimed in 21-25, 27-28, and 40-42.

The Examiner concludes that one having ordinary skill in the art at the time the invention was made would have been motivated to modify *Grollier* by incorporating the dyeing ingredients of cationic polymers and oxidation bases as taught by *de la Mettrie* “to make such a dyeing composition with a reasonable expectation of success.” Office Action, p. 7. The Examiner then concludes that “[s]uch modification would be obvious because the reference teaches compounds structurally similar to those claimed. . . . the

similarities in chemical structure between the prior art and the claimed compounds and which have similar utilities establishes a prima facie case of obviousness.” *Id.*

In effect, the Examiner is utilizing pieces of the disclosure of *de la Mettrie* to argue that it teaches and motivates one of skill in the art to modify *Grollier* to reach the presently claimed invention. This is not evidence of a suggestion or motivation to combine. Instead, it is a conclusory statement with no factual support. As the Federal Circuit has held, broad or conclusory statements will not suffice to demonstrate a motivation to combine. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In addition, without evidence of motivation, “[i]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (additional citations omitted).

Finally, the Examiner is not only applying selected portions of *de la Mettrie*, he is using only selected aspects of *Grollier* as well (e.g., ignoring the required anionic polymer with vinylsulphonic units). Thus, the Examiner is failing to demonstrate obviousness in another respect: he is not considering each reference as a whole, but instead is picking and choosing only those ingredients which together will result in the presently claimed invention. The only possible way to reach the conclusions the Examiner has reached in the Office Action is by use of hindsight, using the present disclosure as a blueprint. And, as the Examiner knows, hindsight reconstruction of the claimed invention is improper.

For the above reasons and other reasons already of record, Applicants respectfully request the Examiner withdraw this improper obviousness rejection.

### III. Conclusion

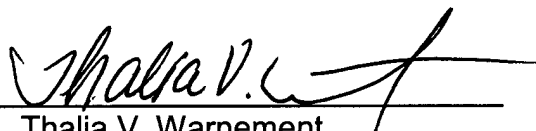
In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner again decide to reject the pending claims, Applicants reserve the right to appeal this decision to the Board. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 3, 2004

By: \_\_\_\_\_



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